

SUMMARY

The above Amendment and following Remarks are responsive to the points raised in the September 29, 2003 Office Action. In the Office Action, claims 1-15 and 40-44 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Claims 1-3 and 8-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Headrick in view of Fehr, Hellström et al, and Snyder. Claims 4-7 and 40-44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Headrick in view of Fehr, Hellström et al, and Snyder and further in view of Taber. Claims 47 and 48 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Headrick in view of Fehr, Hellström et al, and Kurtz. Upon entry of this Amendment, claims 1 and 40 will have been amended to correct minor informalities, claims 16-39, 45 and 46 have been withdrawn from further consideration by the Examiner, and claims 1-48 will be pending in this application. Entry and consideration of this Amendment are respectfully requested.

REMARKS

35 U.S.C. § 112, second paragraph:

Claims 1-15 and 40-44 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Applicants have adopted the Examiner's suggestion to amend claims 1 and 40 for positive antecedent basis. Applicants believe this amendment overcomes the 35 U.S.C. § 112, second paragraph rejections and requests removal thereof.

REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1-3 and 8-15 were rejected under 35 U.S.C. § 103(a) as being obvious over Headrick in view of Fehr, Hellström et al., and Snyder. Claims 4-7 and 40-44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Headrick in view of Fehr, Hellström et al, and Snyder and further in view of Taber. Claims 47 and 48 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Headrick in view of Fehr, Hellström et al, and Kurtz. Applicants traverse these rejections.

The Examiner has failed to establish a prima facie case of obviousness as detailed in MPEP § 706.01(j):

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

A prima facie case of obviousness has not been established because there is no suggestion or motivation to combine the references. Furthermore, all the claim limitations are not disclosed or suggested by any combination of Headrick, Fehr, Hellström et al, Snyder, Taber and Kurtz.

The Examiner continues to reject the claims based on the combination of Headrick, Fehr, Hellstrom and Snyder. However, these rejections are improper as the Examiner has failed to meet his prima facie case burden by failing to point to any teaching or suggestion in Headrick or Fehr to combine those references. As averred by the Applicants, the seal of Fehr is form fit to

the frame therein and this form fit seal would not accommodate the protrusion of Headrick's assembly without modification. Support for making such a required modification is lacking in Fehr and Headrick and since the Applicants have timely traversed the combination as lacking the required motivation, the burden shifts back to the Examiner to provide the teaching or suggestion in either Headrick or Fehr to make the combination. The Examiner has failed to provide such motivation in the present rejection. Without such support, the maintenance of this multiple 103 rejection is improper.

Specifically, in response to the Applicants assertion of lack of motivation to combine these references, the Examiner has failed to show in either Headrick or Fehr a teaching or suggestion to modify the form fit, mitered seal of Fehr onto Headrick. Instead, the Examiner refers to a reference, Taber, which was not the used in rejecting the independent claims. Taber however fails to disclose a teaching or suggestion to support the Examiner's modification of the seal of Fehr to accommodate Headrick. Taber appears instead to disclose a method of producing closure gaskets that seal differently than Fehr, that would not operate in place of the seal in Fehr, and that fails to disclose the end cap seal as claimed. Accordingly, since the only basis provided by the Examiner for combining Fehr and Headrick is a reference, Taber, that is not the basis of the rejection of the independent claims and since Taber fails to provide the required teaching or suggestion to combine Fehr with Headrick to support a prima facie case of obviousness, Applicants aver that the Examiner's maintenance of the rejection is improper and should be removed.

The Examiner asserts that the rationale to modify and/or combine the prior art references may be reasoned from knowledge generally available to one of ordinary skill in the art and that since "the applicant has failed to address the reasoning/rationale supplied by the Examiner as to

why the modification would have been obvious, the applicants' arguments are not persuasive." Applicants respectfully disagree with this assertion. Specifically, Applicants refer the Examiner to the remarks filed in the Amendment and Response of August 18, 2003, on pages 14 through 16, where the Applicants provide evidence of why the modification and/or combination would not have been obvious and why Fehr and Headrick cannot be combined:

Fehr discloses a framing extrusion having a specific profile. The profile is used around the entire perimeter of the door opening (i.e. 15, 16, 17 and 19). In particular, FIG. 3 shows the profile used as vertical jambs 17, 19, and FIG. 4 shows the profile used as a header 16 and a sill 15.

Independent claim 1 of the present application recites an entryway system including a threshold member joined to a frame. An end cap corner key is positioned between the frame and the threshold member. Fehr does not teach or suggest an end cap positioned between the sill 15 and a frame. The Examiner relies upon the combination of Headrick and Fehr to show the recited limitation.

Applicants respectfully submit that neither Fehr nor Headrick provide the teaching or suggestion to modify the profiles of Fehr to include the end cap of Headrick. Fehr specifically states the profiles are standardized, and thereby can be mitered at their ends and joined together by fusion welding. . . ." Column 8, lines 57-62. Because the profiles are standardized, the end pieces correspondingly match one another, and when mitered provide a seal. There is no teaching in Fehr to modify the Fehr profile to include the Headrick end cap.

There is also no teaching in Headrick to modify the Fehr profile to include the Headrick end cap. In particular, Headrick teaches a sill and end cap assembly. The assembly fits between vertical jambs 52 of a door frame. As shown in FIG. 4, "[a] dado 61 is formed in the bottom of the jamb 52 to accommodate the end cap 36, which protrudes slightly beyond the end of the assembly 11. . . ." Column 6, lines 46-50. Because of the standardized profile of Fehr, incorporating the Headrick end piece would require significant modifications in the vertical jamb profiles. Modifying the vertical jamb profiles of Fehr to include the end caps would jeopardize the structural integrity of the profile's web structure. (See Fehr, column 8, lines 47-53, stating that the profiles includes a substantial

amount of structural reinforcing vertical web members and horizontal web members, so as to provide the necessary rigidity as a framing section.) The asserted combination would render the Fehr profile unsatisfactory for its intended use.

For at least these reasons, Applicants respectfully submit that a prima facie case of obviousness to modify the profiles of Fehr to include the end cap of Headrick is lacking. Applicants therefore submit that independent claim 1, and dependent claims 2, 3, and 8-13, are patentable.

Applicants specifically addressed the reasoning/rationale supplied by Examiner and specifically detailed why the proposed combination of Fehr and Headrick does not establish a prima facie case of obviousness. Applicants noted that Fehr provides a form fit, mitered seal joined together by fusion welding and that Headrick provides an end cap assembly, which can arguably incorporate a seal, but only a seal that can accommodate the end cap in the bottom of the jamb that protrudes slightly beyond the end of the assembly. The form fitting seal of Fehr cannot accommodate the protrusion of Headrick without modification, which is not shown in either Fehr or Headrick. Additionally, the modification that would be required to fit the end cap assembly of Headrick would render Fehr unsatisfactory for its intended purpose, which is explicitly prohibited under MPEP 2143.01. Since the Examiner has not provided any teaching or suggestion in the prior art to combine Fehr or Headrick or that such a combination would result in the claimed entryway system, a prima facie case of obviousness has not been established and the rejections based on this combination fail to supply the required motivation to combine.

The burden of establishing a prima facie case of obviousness is initially placed on the Examiner and shifts to the Applicants once a case has been established. After the initial assertion of a prima facie case of obviousness, if the Applicants then provide evidence that a prima facie case of obviousness does not exist, the burden to prove the existence of a prima facie case of obviousness shifts back to the Examiner. Here, since the Applicants have provided evidence that

a prima facie case does not exist, the burden now shifts back to the Examiner to establish that a prima facie case of obviousness does exist. The Examiner must now provide an explanation of how the mitered seal of Fehr could accommodate the protruding end cap of Headrick without rendering Fehr unsatisfactory for its intended purpose, the Examiner has failed to meet his burden of establishing that a prima facie case of obviousness in fact exists. Thus, since the Examiner has failed to meet his burden of prima facie case of obviousness, the rejections under 103(a) are improper and should be withdrawn as unsupported.

With respect to independent claim 40, the Examiner avers that utilizing the economical method of depositing additional material onto a gasket as purportedly taught in Taber would motivate one of ordinary skill in the art to place a seal between the tank in the groove of the end cap 36 in Headrick. Applicants are unable to find any teaching whatsoever in Taber or Headrick to support the assertions forwarded by the Examiner. Specifically, Headrick appears to teach away from sealing between the end cap and frame and Taber does not appear to provide any reasoning whatsoever to motivate one to place this seal therein. Accordingly, the Applicants aver that the rejections applied to claim 40 are improper and should be withdrawn as moot.

Accordingly, the independent claims, as amended for form, are allowable and the dependent claims are allowable for the same reasons as the independent claims from which they depend. Applicants further aver that the rejections are improper as applied and request an early notice of allowance in accordance with the discussion herein.

CONCLUSION

Claims 1-15, 40-44, 47, and 48 are now believed to be allowable and an early notice to such effect is earnestly solicited. Should the Examiner have any questions or comments

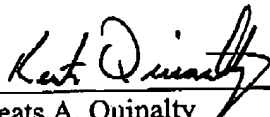
regarding the foregoing Amendment and response, he is invited and urged to telephone the undersigned attorney.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees that may be required for the timely consideration of this Amendment under 37 C.F.R. §§ 1.16 and 1.17, or credit any overpayment to Deposit Account No. 09-0528.

Respectfully Submitted,

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